



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

9

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/581,345	09/27/00	PASTAN	I 15280-339PC

LAURENCE J HYMAN
TOWNSEND & TOWNSEND & CREW
8TH FLOOR
TWO EMBARCADERO CENTER
SAN FRANCISCO CA 94111-3834

HM22/1011

EXAMINER

HELMS, L

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/581,345

Applicant(s)

PASTAN ET AL.

Examiner

Larry R. Helms

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-98 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121:

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

To have a general inventive concept under PCT rule 13.1, the inventions need to be linked by a special technical feature. The special technical feature recited in claim 1 is an antibody which binds to recombinant mesothelin with a dissociation constant of less than $3 \times 10^{-8} \text{M}$ and specifically binds to cells expressing mesothelin on their cell surface. In view of this Brinkmann et al (Int. J. Cancer 71:638-644, 5/1997) as evidenced by Chowdhury et al (Molecular Immunology 34:9-20, 1/97) reads on the claim. Brinkmann et al teach an antibody that binds to recombinant mesothelin (as evidenced by Chowdhury et al) and binds to mesothelin on cells with the claimed affinity. Therefore the technical feature recited in claim 1 is not special. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1. L2A

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-32 and 97-98, drawn to an antibody, a kit comprising the antibody, and compositions comprising the antibody.

Group II, claim(s) 33-75, drawn to expression cassettes and host cells

Group III, claim(s) 76-87, drawn to a method of inhibiting the growth of a malignant cell expressing mesothelin.

Group IV, claim(s) 88-96, drawn to a method of detecting mesothelin in a biological sample.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: As set forth above, in view of the teaching of Brinkmann et al and as evidenced by Chowdhury et al the groups are not so linked as to form a single general concept under PCT Rule 13.1 because the technical feature of claim 1 is not special.

Inventions of Groups I and II represent separate and distinct products which are made by materially different methods, and are used in materially different methods which have different modes of operation, different functions and different effects. The expression cassettes and host cells of Group II and the antibody of Group I are all structurally and chemically different from each other. The polynucleotide is made by nucleic acid synthesis while the antibody is raised by immunization. Furthermore, the polynucleotide/expression cassette can be used for hybridization screening and the antibody can be used to immunopurify the antigen, for example. The examination of all

groups would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus the inventions I and II are patentably distinct.

The methods of Inventions III and IV differ in the method objectives, method steps and parameters and in the reagents used. Invention III recites a method of inhibiting the growth of a malignant cell expressing mesothelin and Invention IV recites a method of detecting mesothelin in a biological. The examination of all groups would require different searches in the U.S. PATENT shoes and the scientific literature and would require the consideration of different patentability issues. Thus Inventions III and IV are separate and distinct in having different method objectives, method steps and parameters and in the reagents used and are patentably distinct.

Inventions I and (III-IV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group I can be used in a materially different method such as to immunoprecipitate the antigen in addition to the materially different methods of Groups III-IV.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different searches in the patent literature, restriction for examination purposes as indicated is proper.

Application/Control Number:
09/581,345
Art Unit: 1642

Page 5

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

5. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located In Crystal Mall 1. The faxing of such papers must conform with the notice published In the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-7401.

Respectfully,

Larry R. Helms Ph.D.


SHEELA HUFF
PRIMARY EXAMINER